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10/567,223	02/03/2006	Bruce Duncan	GB030130	9578

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Philips Electronics North America Corporation
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EXAMINER

HANCE, ROBERT J

ART UNIT	PAPER NUMBER
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4134

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,223	Applicant(s) DUNCAN, BRUCE	
	Examiner ROBERT HANCE	Art Unit 4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/03/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 21 is objected to because of the following informalities: "the receiver" cited in claim 21, line 9 lacks proper antecedent basis. "the receiver" should be changed to -- a receiver --. Appropriate correction is required.

Information Disclosure Statement

2. The information disclosure statement filed 02/03/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of JP200184292A, which is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to

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support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 26-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 26-27 define software embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed software can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-7, 13-14, 18, 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Reto, US Pub No 2002/0144273.

As to claim 1 Reto discloses a terminal for allowing a first user to have a shared experience of media content with a group of other users who are interconnected with the first user via a network (Fig. 1), the terminal comprising: an input for receiving the first user's selection of media content for presentation, substantially in real-time (Fig. 1: Remote control unit 17), by a media presentation device local to the terminal (Fig. 1: Display unit 11), the media presentation device using a delivery mechanism which is independent of the network (Fig. 1: Broadcaster 7 is independent from network 6); means for determining an identifier corresponding to the selected media content (Paragraphs 176 – present content data is sent to other users along with chat requests); means for sending the identifier to terminals of the other users in the group over the network (Paragraph 176 – when the user wants to share (chat) with other users, content identification is sent to other client devices); and, means for allowing the first user to discuss the media content with the other users in the group (Paragraph 176, Fig. 36).

As to claim 2 Reto discloses a terminal according to claim 1 further comprising: means for receiving, via the network, an identifier of media content selected by another user of the group (Paragraph 176; Figures 26 and 37); means for determining a source of media content corresponding to the received identifier (Paragraph 176); and, means for selecting the determined source on a media presentation device local to the terminal

(Paragraph 176; Fig. 37 – if user accepts the invitation to watch a particular program, the client device automatically tunes to the recommended program).

As to claim 3 Reto discloses a terminal according to claim 1 wherein the means for allowing the user to discuss the media content is an internet chat application which communicates with an external host (Fig. 1: see server 5, network 6; Paragraph 176).

As to claim 4 Reto discloses a terminal according to claim 3 wherein the identifiers of media content are sent to, or received from, the external host (Paragraph 176).

As to claim 6 Reto discloses a terminal according to claim 1 wherein the selected media content is a broadcast channel for reception on a broadcast receiver local to the terminal (Fig. 1: see broadcaster 7; tv receiver 12).

As to claim 7 Reto discloses a terminal according to claim 6 wherein the means for determining an identifier is arranged to determine an identifier corresponding to a programme currently being broadcast on the selected channel (Paragraph 176).

As to claim 13 Reto discloses a terminal according to claim 7 wherein the broadcast receiver is a television receiver or a radio receiver (Fig. 1: 12).

As to claim 14 Reto discloses a terminal according to claim 2 wherein, when the selected media content is a broadcast channel, the means for determining a source is arranged to find a corresponding channel on a broadcast receiver local to the terminal (Paragraph 176 – when a user accepts the invitation to watch a particular program, the client device automatically tunes to the recommended program).

As to claim 18 Reto discloses A terminal according to claim 1 in the form of a set-top box (Paragraph 181).

As to claim 21 Reto discloses a terminal for allowing a user to have a shared experience of media content with a group of other users who are interconnected via a network comprising: means for receiving an identifier of media content selected by another user of the group (Fig. 1; Paragraph 176); means for determining a source of media content corresponding to the received identifier (Fig. 1; Paragraph 176); and, means for selecting the determined source on a media presentation device local to the receiver which uses a delivery mechanism which is independent of the network (Fig. 1; Paragraph 176 – source is broadcast television, independent of network 6 - see Fig. 1).

As to claims 22, 24 and 26 see similar rejection to claim 1. The method of claims 22, 24 and 26 corresponds to the terminal of claim 1. Therefore claims 22, 24 and 26 have been analyzed and rejected.

As to claim 23, 25 and 27 see similar rejection to claim 2. The method of claims 23, 25 and 27 corresponds to the terminal of claim 2. Therefore claims 23, 25 and 27 have been analyzed and rejected.

As to claim 28 Reto discloses a method of providing a service to a group of users who are interconnected via a network, comprising the steps of: receiving an identifier of a first user's selection of media content which is to be viewed by the group, the identifier representing the first user's selection of media content which is to be presented in real-time by a media presentation device local to the first user which uses a delivery mechanism which is independent of the network (Paragraph 176; Fig. 1);

sending the identifier to terminals of the other users in the group over the network so as to allow terminals at those users to select the same media content on a media presentation device local to them (Paragraph 176); and, supporting a discussion group to allow the group to discuss the selected media content (Paragraph 176; Figs. 1, 36).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 8, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reto, US Pub No 2002/0144273 in view of Schindler, US Patent No 6,081,830.

As to claim 5 Reto fails to disclose a terminal according to claim 1 wherein the identifier is a unique identifier of the media content. However, in an analogous art, Schindler discloses obtaining a unique identifier of media content through an EPG (col. 4 lines 13-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto with the teachings of Schindler. The rationale for this combination would have been to quickly and easily obtain a unique program identifier, which is contained in the EPG. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would

have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 8 Reto fails to disclose a terminal according to claim 7 wherein the means for determining an identifier is arranged to access a source of programme information to determine which programme is being broadcast on the selected broadcast channel. However, in an analogous art, Schindler discloses accessing an EPG to determine a unique program identifier (col. 4 lines 13-24).

As to claims 11 Reto fails to disclose a terminal according to claim 8 wherein the source of programme information is a broadcast source of programme information. However, in an analogous art, Schindler discloses obtaining a unique identifier of media content through an EPG (col. 4 lines 13-24).

As to claims 12 Reto fails to disclose a terminal according to claim 8 wherein the source of programme information is an electronic programme guide (EPG). However, in an analogous art, Schindler discloses obtaining a unique identifier of media content through an EPG (col. 4 lines 13-24).

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reto, US Pub No 2002/0144273 in view of Schindler, US Patent No 6,081,830 and further in view of Park et al., US Pub No 2003/0101456.

As to claim 9 Reto as modified fails to disclose a terminal according to claim 8 wherein the source of programme information is a source of programme information on the network. However, in an analogous art, Park et al. disclose that the source of

programme information is a source of programme information on the network (Paragraph 24 – broadcast receiving apparatus gets program information from the EPG/tag providing server over the internet; Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto as modified with the teachings of Park et al. The rationale for this combination would have been to use a centralized server to provide program information, thus simplifying updating and maintenance. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 10 Reto as modified fails to disclose a terminal according to claim 9 wherein the identifier is a uniform resource locator (URL) of an entry in the online source of programme information. However, in an analogous art, Park et al. disclose an identifier which is a URL of an entry in the online source of program information (Paragraph 24 - tags contain URLs to program information, which contains broadcast time and date, therefore this URL is unique to the program).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reto, US Pub No 2002/0144273 in view of Thurston et al., US Pub No 2003/0110492.

As to claim 15 Reto fails to disclose a terminal according to claim 2 wherein, in the event that the means for determining a source is unable to locate a source which

can be presented by a media presentation device local to the terminal, the terminal is arranged to find an alternative source having the same content. However, in an analogous art, Thurston et al. disclose a user terminal which accepts a unique program identifier, and the EPG locates and displays the desired program (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto with the teachings of Thurston et al. The rationale for this combination would have been to locate a recommended program in the case that the program viewed by the recommending party and the party to whom the program is recommended are not broadcast on the same channel. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reto, US Pub No 2002/0144273 in view of Thurston et al., US Pub No 2003/0110492 and further in view of Novak, US Pub No 2002/0095689.

As to claim 16 Reto as modified fails to disclose a terminal according to claim 15 wherein the terminal is arranged to find a source on the network having the same content. However, in an analogous art, Novak discloses a set top box that is capable of receiving and decoding internet video streams (Paragraphs 18-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto as modified with the teachings of Novak. The rationale for this combination would have been to locate a recommended program on the internet in the case that the program viewed by the recommending party is not available to the party to whom the program is recommended. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

10. Claims 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reto, US Pub No 2002/0144273 in view of Russ et al., US Pub No 2002/0059642.

As to claim 17 Reto fails to disclose a terminal according to claim 1 in the form of a remote control for operating the media presentation device. Reto discloses that the terminal is a set top box (Paragraph 181). However, in an analogous art, Russ et al. disclose set top box functionality embodied in a remote control (Paragraph 71; Figure 4: 170).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto with the teachings of Russ et al. The rationale for this combination would have been to allow the user freedom of mobility by placing the chat/share functionality in a remote control. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by

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known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 19 Reto fails to disclose a terminal according to claim 1 in the form of a PC. However, in an analogous art, Russ et al. disclose set top box functionality embodied in a PC (Paragraph 83; Figure 4: 425).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto with the teachings of Russ et al. The rationale for this combination would have been to use a user's existing PC as a set top box, instead of requiring that a user purchase additional hardware. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 20 Reto fails to disclose a terminal according to claim 19 wherein the media presentation device is a broadcast receiver housed within the PC. However, in an analogous art, Russ et al. disclose a broadcast receiver housed within a PC (Paragraph 36; Figure 1c; Figure 4: 425).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Reto with the teachings of Russ et al. The rationale for this combination would have been to use a user's existing PC as a set top box and viewing platform, instead of requiring that a user purchase additional hardware. All the

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claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00am - 5:00am EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LunYi Lao can be reached on (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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